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No. 18,629 ✓

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

DYMO INDUSTRIES, INC.,

Plaintiff-Appellant,

vs.

TAPEPRINTER, INC.,

Defendant-Appellee.

BRIEF FOR APPELLEE.

ADELE I. SPRINGER,

3460 Wilshire Boulevard,
Los Angeles 5, California,

J. CALVIN BROWN,

704 South Spring Street,
Los Angeles 14, California,

Attorneys for Defendant-Appellee.

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BRIEF FOR APPELLEE.

Statement of the Case.

The Defendant-Appellee respectfully submits this, the Appellee's Brief, in answer to Plaintiff-Appellant's Opening Brief.

The appeal herein is from an Order of the District Court denying appellant's motion for a *Preliminary Injunction* for alleged trademark infringement.

(All italics in this brief will be supplied unless otherwise indicated).

The Facts.

Appellant claims that appellee's corporate trade-name "Tapeprinter, Inc." and appellee's mark, "TapePrinter", infringe appellant's purported trademark, "TAPE-WRITER", both used in connection with embossing machines to "write" or "print" on "tape". Its claim of unfair competition depends fundamentally on the alleged infringement.

Appellee contests validity of appellant's trademark, upon the grounds that: appellant has failed to establish title or ownership of the trademark in question, third parties having acquired prior rights to the mark; that appellant's *primary* trademark is DYMO and that the word TAPEWRITER is used in conjunction with and as descriptive of the DYMO product; that the mark TAPEWRITER is generically descriptive and cannot be exclusively appropriated; that, in any event, the marks are dissimilar and not likely to cause confusion as to *origin* of the product; and that, in addition, appellant's unclean hands, misuse, laches and estoppel, bar any relief. The issue of secondary meaning is not involved, not having been alleged, claimed or proved. The appellant, however, attempts to raise the question for the first time on appeal.

Appellee contends that the marks involved herein, when considered in their entirety, are phonetically and visually distinct. Nor are the color schemes, designs and inscriptions of the respective marks sufficiently similar to cause confusion. There is no suggestion in the record that any confusion has arisen during the period of concurrent use.

It is significant that appellant uses its corporate name DYMO as its *primary* trademark, in conjunction with and displayed more prominently than the descriptive mark TAPEWRITER, thus constituting an additional distinction. [Exs. A-F, pp. 11-16.] Of added significance is the Registration symbol appearing after the mark DYMO without its appearance after the mark TAPEWRITER [Ex. D. Tr. p. 14], notwithstanding registration of the TAPEWRITER mark and the mere pendency of application for registration of the DYMO mark in said classification. [Ex. E, Tr. p. 141.]

The Record shows at least 574 third-party registrations and Common Law marks which include either the term “tape” or the word “write” or its phonetic equivalent “rite”, or “printer”, for goods stated to be in various phases of the tape field, and in other fields for a variety of products, some of them in the same classification. [Exs. A through D, Tr. pp. 90-140.] Included in the Exhibits are a number of Affidavits of third party registrants attesting to such prior adoption and use. [Tr. pp. 93-104.] Appellant’s registration of the mark TAPEWRITER was subsequent to third parties’ prior registrations and/or common law prior rights in trademarks and trade-names under the respective names of TAPE-RITER, TAPERITE, TAPE-RITE COMPANY, TAPE-RITE CO., TAP-RITE, TAPRINT, INDUSTRIAL TAPE PRINTERS, YORK TAPE PRINTERS, INC., and other similar names. [Tr. pp. 90-91.]

Appellant, in its “Argument on the Merits”, refers to the cancellation of the TAPE-RITE third party registration of Permoflux, but fails to mention that the State Registration was cancelled because of the registrant’s removal from that State and that its affidavit in the Record attests to its continued use as a common-law trademark. [Ex. A, Tr. p. 93.] Nor does appellant refer to the other proofs in the record of the prior adoption and continued use by other of the third party owners of common law marks.

Many issues, apart from confusion, are involved in this case, which cannot be properly beyond dispute on the affidavits and pleadings at this stage of the proceeding. These include not only the question of appellant’s right to the trademark but also the defenses of

unclean hands, misuse, laches, acquiescence, estoppel, monopoly, and other issues of fact in the Record.

The record has not disclosed any predatory conduct on the part of the appellee. It has not been shown that appellee cannot respond in damages, or that appellant does not have an adequate remedy other than by preliminary injunction. Although appellant claims irreparable injury, no showing has been made beyond conclusory statements in its affidavits. There is no factual statement of any loss of sales. Nor is there one word in the record as to the effect of the supposed similarity of the products upon the market. To the contrary, appellant's business has increased, notwithstanding its claims of alleged infringement and unfair competition.

A preliminary injunction herein would be equivalent to a final decree for the appellant. The appellee would be subjected to great and irreparable injury were a preliminary injunction to issue herein.

The District Court's denial of preliminary injunction herein was based on the finding of fact "that there is *great doubt* as to whether or not the plaintiff has the exclusive right to use the word TAPEWRITER".

Questions Presented.

1. Whether a preliminary injunction may issue where the Court finds that "there is *great doubt* as to whether or not the plaintiff has the exclusive right to use the word TAPEWRITER".

2. Whether injunctive relief may be granted where appellant has failed to establish ownership of the trademark in question.

3. Whether registration can confer title to a trademark where third parties acquired prior rights by earlier adoption, use and registration.

4. Whether the mark in question is merely descriptive of a primary mark where appellant's corporate name DYMO is used in conjunction with the mark TAPEWRITER and the registration symbol appears after the primary mark DYMO.

5. Whether appellant's use of the registration symbol after the mark DYMO prior to such registration bars relief.

6. Whether, in any event, the mark TAPEWRITER, composed of two common words of the English language, describing the function of the product, is generically descriptive and incapable of exclusive appropriation.

7. Whether, in any event, the marks, being dissimilar phonetically and visually, are likely to cause confusion as to *origin* of the product.

8. Whether, in any event, numerous third-party registrations of the mark are indicative of unlikelihood of confusing similarity.

9. Whether appellant is entitled to injunctive relief pending trial without any showing in the Record of irreparable damage to plaintiff or of defendant's inability to respond in damages, and where a preliminary injunction would be equivalent to a final decree for the appellant, to the irreparable injury of appellee.

10. Whether appellant is barred by unclean hands, misuse, laches and estoppel, from any relief.

11. Whether the District Court's findings of fact, supported by the Record, can be disturbed on appeal.

Appellee's Contentions.

1. The District Court properly denied a preliminary injunction based upon the finding "that there is great doubt as to whether or not the plaintiff has the exclusive right to use the word TAPEWRITER".

2. The authorities relied upon by appellee herein, furnish persuasive reason for affirming the Order denying injunctive relief.

3. The cases relied upon by appellant as authorities, are distinguishable and inapplicable.

4. The latest decision in the Ninth Circuit on the subject of the issues herein was decided in favor of defendant. The case at bar is *a fortiori*.

5. Appellee contests validity of appellant's trademark. The burden is on appellant to prove its ownership of the mark to establish infringement.

6. Appellant has failed to sustain such burden of proof and has not established title to the mark.

7. Third Parties acquired prior rights to the mark which bars any relief to appellant.

8. Registration cannot confer title to a trademark where a third party has acquired a prior right by adoption and use.

9. In any event, third party registrations are elements to be considered in passing on any question of likelihood of confusion.

10. The fact that any of the registrations have expired or have been cancelled does not negate their evidentiary value as showing weakness of term as part of the mark.

11. Third party registrations have weight in showing that the prefix or suffix of a mark is either descriptive or suggestive.

12. The greater the number of similar third party marks, already in use, the less likelihood that their products will be associated or attributed to one source.

13. The 570 marks comprising the term “tape” or “write” are far more than the number of third party registrations considered in many court decisions as determinative of unlikelihood of confusion.

14. It has always been the rule that any such generically descriptive term (as “tape” and “write”) may not be exclusively appropriated as a trademark, in any event.

15. It is obvious that appellant’s TAPEWRITER mark is “weak” as an indicator of *source* or *origin* of the goods.

16. The law does not recognize a monopoly of the English language. Appellant has no exclusive right to the use of the mark.

17. Appellant has not, for purposes of this motion at least, clearly established its right to exclusive use of the trademark in question.

18. Nor is there any question of secondary meaning involved in this case.

19. The marks involved herein, when considered in their entirety, are phonetically and visually distinct.

20. Appellant’s mark, DYMO, coupled with its mark TAPEWRITER, constitutes an additional distinction.

21. The more prominent display of the DYMO mark makes DYMO the *primary* trademark coupled

with the TAPEWRITER mark as descriptive of the product.

22. The mark, TAPEWRITER, obviously describes the function of the product.

23. The best evidence of likelihood of confusion is actual confusion. No instance of confusion has been presented. Mere "possibility" is not enough.

24. Any doubts created by appellant's record must be resolved against it. It must be presumed that plaintiff made the strongest showing possible.

25. The moving papers do not establish that a denial of preliminary injunction will cause irreparable damage to plaintiff's pending action. No showing has been made beyond conclusory statements in its affidavits. There is no factual statement of any loss of sales or of the effect of the supposed similarity upon the market. To the contrary, plaintiff's business has increased, notwithstanding its claim of unfair competition.

26. It has not been shown that defendant cannot respond in damages, or that plaintiff does not have an adequate remedy other than by preliminary injunction.

27. It is a cardinal principle of equity jurisdiction that a preliminary injunction shall not issue in a doubtful case.

28. A preliminary injunction herein would be the equivalent to a final decree for the plaintiff.

29. The general purpose of a preliminary injunction is to maintain the *status quo*, and not to require the defendant to make such changes in its business

that, in the event it should succeed on final hearing, the injury caused to it by the preliminary injunction would be irremediable.

30. It is axiomatic that a stronger case must be presented by a party seeking a preliminary injunction in advance of trial than for similar relief after trial.

31. Defendant is entitled to have all the facts and circumstances as to the use of the mark, the purposes and intents of the parties, and the probable effect of continued use of the mark, presented to the Court at a trial before the Court can properly determine such issues.

32. Many issues, apart from confusion, are involved in this case, which cannot be properly beyond dispute, on the affidavits and pleadings at this stage of the proceeding. These include not only the question of plaintiff's right to the trademark but also the defenses of unclean hands, laches, acquiescence, estoppel, monopoly, misuse, and other issues of fact.

33. It is well established that the issues of laches, acquiescence or estoppel bar injunctive relief.

34. It has consistently been held that the issue of unclean hands bars a preliminary injunction; that the defendant is entitled to present the issue on evidence at a trial.

35. Plaintiff's misrepresentation of the registered symbol on its DYMO mark used in conjunction with its TAPEWRITER mark, and the threats made by plaintiff against defendant, estop the plaintiff, and its "unclean hands" bar injunctive relief at least preliminarily.

36. The plaintiff, under the guise of unfair competition, is attempting to create a perpetual monopoly. Economic competition rather than monopoly should be encouraged.

37. The District Court's finding herein is not "clearly erroneous", but, to the contrary, is clearly supported by the Record and by law and reason.

38. It is, therefore, respectfully submitted, that the Order appealed from, be affirmed.

POINTS AND AUTHORITIES.

POINT I.

A Preliminary Injunction Cannot Issue in a Doubtful Case. Findings of Fact Supported by the Record May Not Be Disturbed on Appeal.

The District Court, in determining the issues of fact herein, made the finding “that there is *great* doubt as to whether or not the plaintiff has the exclusive right to use the word “TAPEWRITER”.

Such finding of fact may not be disturbed on appeal.

The Courts have uniformly held that, where doubt exists, an injunction shall not issue.

The Supreme Court of the United States long ago admonished, in *Trudy v. Wanzer*, 5 How. (46 U. S.) 140 (1847), at page 142:

“There is no power, the exercise of which is more delicate which requires greater caution, deliberation, and sound discretion or more dangerous in a doubtful case, than the issuing an injunction”.

This Court, in the recent case of *Coast Metals Inc. v. Wall Colmonay Corporation* (9th Cir., No. 18,173 March 27, 1963), at page 4, restated the rule, that:

“The findings of the Trial Court will not be disturbed unless *clearly* erroneous. (Citing authorities).”

This Court has held, in affirming denial of an injunction in an action for trademark infringement, that “essentially, the question is one of fact”. (*Miles Laboratories, Inc. v. Frolich*, 132 U. S. P. Q. 122 (9th Cir., Dec. 1961) (affirming 130 U. S. P. Q. 18).)

The Supreme Court of California has held, to the same effect, "it is a question of fact to be determined from all circumstances of the case". (*Schwartz v. Slenderella Systems of California, Inc.*, 102 USPQ 177 (1954).)

The pronouncements of courts in other Circuits, equally apply here. The Chief Justice of the Second Circuit Court, in *Huber Baking Co. v. Stroehmann Bros. Co.*, 208 F. 2d 464 (1953), in affirming the denial of a preliminary injunction, pointed out, at page 467:

"Indeed, so much is left *doubtful* on the record here made that the denial of a preliminary injunction was well within the bounds of *sound discretion*. (Citing authorities)."

The authorities are all to the same effect, as pointed out in the recent trademark infringement case of *Interlego A.G. v. Leslie-Henry Co. Inc.*, 136 USPQ 601 (Feb. 1963), at page 602, on denial of a motion for preliminary injunction:

"A preliminary injunction should be granted only in a clear case. The court must be satisfied that it is necessary to prevent irreparable injury during the pendency of the action. The party seeking the injunction must show at least a reasonable probability of success in the principal action. The court should balance the inconveniences and injuries which will be caused by the grant or denial of the injunction. *Warner Bros. Pictures Inc. et al. v. Gittone*, 3 Cir. 1940, 110 F. 2d 292; *Joseph Bancroft & Sons Co. v. Shelley Knitting Mills, Inc.*, 3 Cir., 1959, 268 F. 2d 569,

122 USPQ 113; *Speedry Products Inc. v. Dri Mark Products Inc.*, 2 Cir. 1959, 271 F. 2d 646, 123 USPQ 368.”

The “balance of convenience” was stated by *Callman* in *Volume 4* of his text on *Unfair Competition and Trademarks*, at page 1826, as follows:

“In balancing the equities the following considerations are pertinent. On the part of the plaintiff: A *clear* case must be established with respect to the right of, and injury to, the plaintiff; if there is substantial *doubt* on either point, the preliminary injunction should be *denied*. This may, of course, be a question of fact. That is, it may be open to doubt whether the plaintiff’s mark had acquired a secondary meaning, whether the plaintiff was himself chargeable with laches, or whether he had abandoned his right. If a question cannot be decided except upon the presentation of voluminous evidence, or if the facts asserted by plaintiff are controverted under oath, a preliminary injunction will not be granted.”

Callman additionally pointed out, at page 1830:

“A preliminary injunction is not a precautionary remedy. The damage must be imminent. The plaintiff’s own conduct, for instance, when the defendant asserts that he seeks equity with unclean hands, may bar a preliminary injunction. If the defendant would be subjected to great and irreparable injury because of the issuance of a preliminary injunction, such relief will be denied.”

This is particularly true in the case at bar.

It is well settled that a stronger *prima facie* case must be presented by plaintiff seeking a *preliminary* injunction against unfair competition than when seeking similar relief after trial.

This Court has repeatedly held that “It is so well settled as not to require citation of authority” that the usual function of a preliminary injunction is to preserve the *status quo* pending a determination of the action on the merits and is not to grant the moving party the full relief to which it might be entitled at the conclusion of a trial.

The case at bar is *a fortiori*.

POINT II.

Registration in Itself Does Not Create a Trademark nor Is It Determinative of Its Validity. Appellant Cannot Restrain Use of a Mark to Which Registration Appellant Was Not Entitled.

This Court, in the recent case of *Pacific Supply Cooperative v. Farmers Union Central Exchange Incorporated et al.* (9th Cir., No. 17,967, June 3, 1963), restated the rule, at page 20, that:

“Trademark Rights are not dependent on statutory enactment, but arise under common law from prior exclusive appropriation or adoption and use. (Citing authority).”

The authorities are all in harmony, to the same effect. As was pointed out, in *The W. E. Long Co. Independent Bakers' Cooperative v. Burdett*, 134 USPQ 147 (June 1962), by the West Virginia Supreme Court of Appeals, at page 151:

“The law is well settled by the decisions of appellate courts in many jurisdictions that federal

and state statutes do not create a trademark; (citing authority). * * * *Registration cannot confer a title to a trademark, if some other person has acquired a prior right by adoption and use; nor can it vest a title in the registrant as against the common law title of another person. Coca-Cola Company v. Stevenson*, 276 F. 1010; *Carroll & Son Company v. McIlwaine & Baldwin, Inc.*, 171 F. 125. * * * The mere registration of a trademark does not of itself confer any greater rights than existed at common law without registration but *only procedural* advantages and does not enlarge the substantive rights of the registrant. (Citing authorities.) * * * In the opinion in *United States Ozone Company v. United States Ozone Company of America*, 62 F. 2d 1019, 66 USPQ 232, 238, are these statements: “Registration of a trademark * * * in itself gives no property right in the mark. (Citing authorities). *Nor is such registration controlling in a suit involving the common-law rights to the registered mark or in a suit for unfair competition involving its use. B. F. Goodrich Co. v. Kenilworth Mfg. Co.*, Cust. & Pat. App., 40 F. 2d 121, 5 USPQ 76; *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 47 S. Ct. 284, 71 L. Ed. 478.”

As was expressed in the recent case of *General Controls Co. v. Hi-G, Inc.*, 136 USPQ 570 (Dec. 1962), at page 575:

“There is little force in the *mechanical argument* that merely because ‘hi-g’ was accepted for registration, the plaintiff may preclude all others from making any use of that mark in commerce. (Citing authorities).”

And, as expressed by the Chief Justice of the Court of Appeals for the District of Columbia, in *Robertson v. United States*, 287 Fed. 942, at page 945:

“The owner of a trademark could secure nothing which he did not have before, except a presumption which might be overturned by proof.”

As stated by the Second Circuit Court of Appeals, in *Spiegel v. Zuckerman*, at page 64:

“Such *prima facie* proof may be overcome, if it be made to appear that the applicant was not entitled to the particular trademark which he sought to appropriate.”

The Appellant's trademark, in question herein, is not incontestible. Appellee contests its validity on each of the grounds set forth in the separate Points, *infra*.

POINT III.

Appellant Who Is Infringing an Earlier Trademark of a Third Person Cannot Maintain Any Action Against Appellee Founded on Infringement of Trademark in Which Appellant Has No Ownership or Property Rights.

It is axiomatic that appellant must prove its ownership of the trademark to establish infringement.

The appellant herein cannot establish title to the mark, since third parties acquired prior rights thereto. Appellant's registration of the mark TAPEWRITER was subsequent to third parties' prior registrations and/or common law prior rights in trade-marks and trade-names of the same or substantially same name.

The Supreme Court of the United States held, in the early case of *Ubeda v. Zialcita*, 226 U. S. 452,

57 L. Ed. 296, 33 S. Ct. 165, that any action founded upon the infringement of trademark, where the complaining party is itself guilty of infringing an earlier mark of a third person, must be defeated in such infringement suit, even where the owner of the earlier trademark may have had no registered title.

Mr. Justice Holmes, who delivered the Opinion of the Court, pointed out, at page 452:

“It was a matter to which he (the defendant) could refer when the *plaintiff sought to exclude him from doing just what the plaintiff had done himself*”.

Mr. Justice Holmes denounced such conduct as “unclean hands” which debarred plaintiff from maintaining suit, and declared:

“Imposition on the public is not a ground on which the plaintiff can come into court, but it is a very good ground for keeping him out of it.”

The case has been much cited for its holding that, one, whose registered trademark is an imitation of an earlier though unregistered trademark, cannot restrain a third party from using it.

In following this decision, the Court, in *Prichard & Constance v. Aime Co.*, 5 Fed. Supp. 282, denying injunctive relief, pointed out, at pages 283-284:

“Plaintiff has by its actions shown what it believed as to the lack of similarity of the words AMAMI and AIMEE when it registered its trademark; the trademark AIMEE being then registered.

“Actions speak louder than words. * * *

“But I must and do assume that plaintiff’s officers did not consider its name AMAMI so similar to the Hudnut trademark as to infringe.

* * *

“If the word AMAMI is imitated by the user of the word AIME, then it would seem to me that the word AMAMI was an imitation of the word AIMEE, and that, if plaintiff’s trademark was an imitation of Hudnut’s, an *earlier* registered one, *plaintiff cannot restrain the defendant from using it. Ubeda v. Zialcita*, 226 U. S. 452, 33 S. Ct. 165, 57 L. Ed. 296.”

Similarly, in the case at bar, “plaintiff has by its actions shown what it believed as to the lack of similarity of the words” TAPEWRITER and TapePrinter when appellant registered its trademark TAPEWRITER; the mark TAPEPRINTER and its phonetic equivalent TAPRINT being then registered and in common law use by others, when plaintiff registered its mark TAPEWRITER.

The case at bar is *a fortiori*. The word TAPEWRITER and its phonetic equivalent, TAPERITER and similar words, TAPERITE and TAP-RITE, had been previously registered by others, and in common law use, when Appellant registered its mark TAPEWRITER.

The Courts have uniformly barred relief under such circumstances.

In the more recent case of *O'Connor & Gordon, Inc. v. By-Line Publications, Inc.*, 104 USPQ 130 (N. Y. S. Ct.) (1955), it was stated, at page 132:

"The mere fact that there is at least one magazine using the name "QUICK" in addition to the plaintiff is sufficient to defeat the plaintiffs in this litigation. The use of the name must be exclusive and registration in itself does not create a trade mark nor is it essential to its validity. (Rockowitz Corset & Brassier Corp. v. Madame X Co. Inc., 248 N. Y. 272.)"

It was similarly held, in *Neuhoff Brothers v. Oscar Meyer Packing Company, Inc.*, 98 USPQ 195 (1953 D.Ct. N.D. Tex.), that one may not, by common law right or trade mark registration, claim right in a mark previously claimed and used by others. The Chief Judge there pointed out, at page 195:

*"There has been a continued use of this word, and, of these words, on various, and, sundry pork sausage outputs throughout the nation for a number of years prior to the securing of the trademark in Texas by the plaintiffs. Plaintiff may not by a common-law right, or, even by a copyright, claim that which has already been claimed and used by others. * * **

"I think the law should keep its hands off here."

In the recent case of *Younker v. Nationwide Mutual Insurance Co.*, 137 USPQ 901 (June 1962), the Ohio Supreme Court declared, at pages 904-905:

"Such rights belong to the one who first actually adopts and uses the name or mark in connection with his business. (Citing authorities)."

In an earlier case, *Benjamin Moore & Co. v. Auwell*, 178 Fed. 543, the Second Circuit Court of Appeals held, at page 544:

“Although the word MURESCO is itself sufficiently fanciful and nondescriptive to be a good trademark, *it was not open to the complainant when adopted* * * *. Prior to that time * * * there was on sale in this country an English-made wall covering of somewhat similar character, which was known to the trade under the name DURESCO * * *. *With this latter word already appropriated to such goods as a legitimate trademark, no one could, by merely changing its first letter from D to M, acquire any right to insist that the slightly modified word should be recognized as the trademark of his own goods.* *O’Rourke v. Central City Soap Co.* (CC) 26 Fed. 576.”

Similarly, in the case at bar, the plaintiff cannot, “by merely changing its first letter” by adding the letter “w” to the word “rite”, “acquire any right to insist that the slightly modified word should be recognized as the trademark of his goods”, since third parties had prior thereto adopted the trade marks and trade names TAPEWRITER and TAPERITE and the other similar prior registered and common law marks. To paraphrase the Second Circuit Court, “it was not open” to plaintiffs when it adopted the mark TAPEWRITER in 1960.

In *Estateblissements Rene Beziere, S.A. v. Reid, Murdock & Co.*, 48 F. 2d 946 (CPPA), it was succinctly stated, at page 949:

“Apparently appellee did not have the right to use the mark in 1890, nor did appellant in 1893,

and as against each other neither could claim priority."

In *Robertson v. United States*, 287 Fed. 942, the Court of Appeals for the District of Columbia, pointed out, in the Opinion by the Chief Justice, at page 945:

"If, in a contest between a registrant and one who is using the same mark upon the same class of goods, the latter can establish that he is the owner of the mark, *the registration of it will avail the other party nothing.*"

Accordingly, Appellant's registration of the mark herein, "will avail it nothing", in view of third parties' ownership of the mark at the time appellant purportedly adopted the mark.

As was pointed out, in *The W.E. Long Co. Independent Bakers' Cooperative v. Burdett, supra* (134 USPQ 147), at page 151:

"Registration cannot confer a title to a trademark, if some other person has acquired a prior right by adoption and use; nor can it vest a title in the registrant as against the common law title of another person. *Coca-Cola Company v. Stevenson*, 276 F. 1010; *Carroll & Son Company v. McIlwaine & Baldwin, Inc.*, 171 F. 135."

It was similarly held by the Supreme Court of the United States with respect to corporate names as the cases have held with respect to trademarks:

Goodyear's India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co., 128 U. S. 598, 32 L. Ed. 535, 9 S. Ct. Rep. 166, was a suit by a corporation to restrain the use in business of the same or equivalent

name. Mr. Justice Field, in holding that such descriptive names could not be exclusively appropriated, said:

*“The principle that one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right, is sustained by the discussion in Columbia Mill Co. v. Alcorn, 150 U.S. 460, 37 L. Ed. 1144, 14 Sup. Ct. Rep. 151, and is, we think, necessarily applicable to all names *publici juris*. (citing authorities.)”*

The principle is equally applicable to the case at bar wherein plaintiff seeks to restrain defendant not only from using its trademark but also its corporate name. Accordingly, the Appellant not only is without property right in its trademark due to third parties' prior ownership of the mark but also because the name, in any event, is *publici juris* and not subject to exclusive appropriation. It, therefore, follows, as a necessary corollary, that, under either or both theories, the appellant is not entitled to any such restraint against the defendant.

The Second Circuit Court of Appeals, in *The Warner Brothers Company v. Jantzen, Inc.* (1957), 249 F. 2d 355, 115 USPQ 258, declared, at page 353, in holding that the mark CURVALLURE does not infringe the mark “A'LURE”:

*“The plaintiff asks too much in seeking a private monopoly in the common word ‘allure’ as applied to certain articles of feminine adornment and apparel. As the court found * * * this word or coined words derived therefrom ‘have for a long period of years been utilized as advertising for various types of feminine accoutrements’.”*

In the recent case of *London Records, Inc. v. Audio Fidelity, Inc.*, 134 USPQ 142 (May 1962), registration of the trademark AUDIO FIDELITY was cancelled, where others in the trade had used the words and similar terms separately and in combination to describe their goods. It was there held:

“It is concluded that the term ‘audio fidelity’ is nothing more than an apt term for describing phonograph records and that respondent’s registration thereof is damaging to petitioner’s right to the free use of the term to describe phonograph records of its manufacture.”

To the same effect, the Appellant’s mark herein, TAPEWRITER, is “nothing more than an apt term for describing tape writers”, and that Appellant’s registration thereof “is damaging to defendant’s right to the free use of the term to describe” tape printers of its manufacture.

In the recent case of *Seven-Up Co. v. Get-Up Corp.*, 137 USPQ 871 (May 28, 1963) (D. Ct. ND Ohio), in an action for trademark infringement and unfair competition, in rendering judgment for defendant, the Court considered not only the prior registrations but also the generic nature of the mark. The Chief Judge pointed out, at page 873:

“I take it there can be no question here but that the word ‘UP’ does not in and of itself belong to plaintiff *exclusively*. It appears that *others used ‘UP’ as a suffix, if I may so denominate it, some years before plaintiff, and that a large number of other Companies have used it over the years and use it today.*

“‘UP’ in law is no more plaintiff’s property than the word ‘steel’ belongs to United States Steel or Bethlehem or twenty other Steel Companies.”

In *Spiegel v. Zuckerman*, 188 Fed. 63, the Second Circuit Court emphasized, at page 64:

“Many different persons used it, in many different places. *It is not necessary to find that any one of these has used the word as a trademark so long and so continuously that he, rather than complainants, is entitled to exclusive ownership. It is quite sufficient to dispose of this appeal to find, as we do and as the Circuit Court found that in and prior to 1901 the word PRINCESS was being used by so many different persons in connection with the sale of shirtwaists and similar garments, and had been so used for so long a time, that complainants could not, by adopting it as a mark for their own, acquire any exclusive right to its use as such mark.*”

The impropriety of injunctive relief in such case where plaintiff has not acquired exclusive right to use of the mark, was pointed out by *Nims* in *Volume 1* of his text on *Unfair Competition, 4th Edition*, in *Section 384*, as follows:

“*Defendant may attack the plaintiff’s title by asserting that some third party, perhaps a stranger to the suit, is the rightful owner of the mark and that the plaintiff is himself an infringer of that stranger’s rights. * * * To maintain their bill for an infringement the plaintiffs are bound to show an exclusive right to use the mark. If it appears that the words were in common*

use to designate the article of manufacture, or if the exclusive right to use them was vested in another, we apprehend that the plaintiffs are no more entitled to an injunction than is the patentee of an invention who fails to show that he is the first and original inventor of the thing patented.

* * * The fact that the defendant has no better right to the use of the trade-mark than the plaintiff *would certainly not entitle the latter to an injunction.* (Citing authorities).”

POINT IV.

Appellant’s Use of Its Corporate Name Dymo as Its Primary Trademark Coupled With Use of Its Trademark Tapewriter as Descriptive of Its Product, the Tapewriter Mark Alone Cannot Be Held to Identify the Source of Origin or to Vest Exclusive Right of Use.

The District Court’s finding “that there is *great doubt* as to whether or not the plaintiff has the exclusive right to use the word “TAPEWRITER”, was based not only on the question of Appellant’s ownership of the mark because of third parties’ prior rights thereto, but also on the fact that Appellant herein has been using its corporate name, *DYMO*, as its *primary* trademark, preceding the word *TAPEWRITER* which is merely descriptive of its product, while the primary mark *DYMO* is more conspicuously displayed as to lettering, size, and emphasis, and is known as a *DYMO* machine with the *DYMO* as the source of origin.

In the case of *Minnesota Mining & Mfg. Co. v. Sprague Electric Co.*, 126 USP Q240 (1950) (Re-hearing CCPA), the Court considered the meaning of

primary marks, in the mark, “UNIPAK” as applied to goods of both parties. It was held, at page 242:

“UNIPAK is used by appellant to identify and describe its container, not the source of its resins. Without exception, the many advertisements and other exhibits that appellant introduced in evidence show that UNIPAK modifies the container in which the resin are packaged, and that *the resins themselves are identified by the mark ‘SCOTCHCASE’*. * * * .

“It is apparent that appellant is endeavoring to condition the purchasing public to recognize ‘Scotchcase’ as the identifying mark of its resins and UNIPAK as the type of container used for them. We are not convinced that MMM’s registered UNIPAK mark has been so used that it has acquired trademark significance with respect to the epoxy resins of its manufacture. * * *

“Opposer’s use of UNIPAK, not as a trademark for its merchandise (which is ‘Scotchcast’ resin), but as a secondary trademark only for the type of container in which that merchandise is sold.”

The case at bar is *a fortiori*. Appellant, in addition to registration of the mark TAPEWRITER, has also registered the mark DYMO-MITE in the same Class 23 for embossing machines, and has registered the mark DYMO in Class 50 for its Embossing Tapes. Plaintiff’s Exhibit “D” [Tr. p. 14], shows its advertising material as “DYMO M-5 Tapewriter”, with the registration symbol after the word DYMO and not after the word Tapewriter, and with the word DYMO

in larger and heavier lettering than the word Tapewriter. In Exhibit “E” [Tr. p. 15] Appellant refers to its “New DYMO instant labelmaker”, without even mentioning the word Tapewriter and with the registration symbol after the word DYMO. On the picture of the DYMO Tapewriter machine, it appears that words DYMO TAPEWRITER are molded onto the machine itself. Its Exhibit “B” [Tr. p. 12] refers to its DYMO MITE TAPEWRITER but the picture of the machine shows only the words DYMO MITE molded on to the machine without the word TAPEWRITER.

Accordingly, to paraphrase the aforesaid decision, “it is apparent that appellant is endeavoring to condition the purchasing public to recognize “DYMO” as the identifying mark of its products and “TAPEWRITER” merely as descriptive of its DYMO product.

The Supreme Court of the United States, in *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 305 (1938), reversed an injunction in a suit to enjoin unfair competition in use of the name “SHREDDED WHEAT”. Mr. Justice Brandeis, in holding that no exclusive right to its use may be acquired of a generic term, pointed out, at page 120:

“The Kellogg cartons bear *in bold script* the names ‘*Kellogg’s* Whole Wheat Biscuit’ or ‘*Kellogg’s* Shredded whole wheat Biscuit’ *so sized and spaced as to strike the eye as being a kellogg product.** * *

“But the name *Kellogg* was *so prominent* on all of the defendant’s cartons *as to minimize the possibility of confusion.*”

In the recent case of *General Controls Co. v. Hi-G, Inc.*, 136 USPQ 570 (Dec. 1962) (D. Ct. Conn.), where plaintiff sought injunction against use by defendant of its corporate name, the Court, in holding for Defendant in the action for trademark infringement and unfair competition, pointed out, at page 576:

“Finally, since the plaintiff prominently features both its primary mark ‘GC’ and its corporate name in full in all advertisements in which its trademark ‘hi-g’ appears, the mark ‘hi-g’ standing alone cannot be held to have taken on a secondary meaning as a source of origin of products made by General Controls. The fact is that the plaintiff has never weaned the ‘hi-g’ mark from its parent.”

In the recent case of *Wembley Inc. v. Diplomat Tie Co.*, 137 USPQ 107 (March 1963) (D. Ct. D. Md), in an action for trademark infringement and unfair competition, the Court, in holding for the defendant, pointed out, at page 119:

“This construction by plaintiff of its own alleged trademark, although not binding this court, is not without significance and indicates that ‘Color’ is the dominant word in ‘Color Guide’.”

It, similarly, is not without significance that Appellant’s own construction of its trademarks indicates that “DYMO” is its primary trademark and the dominant word in “DYMO TAPEWRITER”. Such construction is fortified by its use of the registration symbol after the word “DYMO” and not after the word “TAPEWRITER”, as shown by the Record.

POINT V.

Appellant's Misuse of the Registration Symbol on Its Trademarks Bars Any Right to Relief.

It appears from the Record that Appellant's registration of the name "DYMO" was for its tape product in Class 50 and not for its embossing machines in Class 23, and that its application for registration in Class 23 for its embossing machines was filed November 26, 1962 and still pending, and that the use of the registration symbol in advertising the "DYMO" mark on its embossing machines prior to such registration, bars the right to any relief.

In a case in the New York Supreme Court it was held on an appeal from an order denying a preliminary injunction to restrain the imitation of a soap wrapper, that an untrue statement on the wrapper, that the form of cake and wrapper "were protected by a trademark secured", was sufficient to bar the right to relief. (*Brown v. Doscher*, 49 N. Y. S. R. 196, 20 N. Y. Supp. 900.) This case subsequently reached the Court of Appeals on an appeal from a judgment dismissing the complaint. The latter court, in affirming the judgment on the ground that no infringement was shown, said: "If we had reached the conclusion that the plaintiff were entitled to judgment, then the legal question presented by this false statement would have required careful examination, but as the case stands we prefer to rest our decision upon the merits". (147 N. Y. 647, 42 N. E. 268.)

The Supreme Court of the United States, in *Worden & Co. v. California Fig Syrup Co.*, 187 U. S. 516 (1903), 47 L. Ed. 282, 23 S. Ct. 161, long ago declared it "well settled" that the owner of a trademark

seeking to enjoin another from injuring him by false representation, cannot ask aid of equity where he is guilty of misrepresentation in trademark which he seeks to protect. It was stated, at page 528:

“When the owner of a trademark applies for an *injunction* to restrain the public, *it is essential* that the plaintiff should not in his trademark, or in his advertisements and business, be himself guilty of any false or misleading representation; that if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he *loses his right to claim the assistance of a court of equity.*”

The Court concluded, at page 537:

“*It is well settled* that if a person wishes his trademark property to be protected by a court of equity, he must come into court with clean hands, and if it appears that the trademark for which he seeks protection is itself a misrepresentation to the public by fraudulent misrepresentations in advertisements, *all relief will be denied to him.* This is the doctrine of the highest court in England, and *no court has laid it down with any greater stringency than the Supreme Court of the United States.*

“The more recent cases evidence no disposition to modify the rule.”

In following the quoted rule, the Court, in *Channell Chemical Co. v. H.W. Hayden Co.*, 222 Fed. 163 (D. Ct. ND Ohio), held, at pages 163-5:

“*But there is in this case an insuperable objection to giving the complainant any relief whatever.*

(Quoting *Worden v. California Fig Syrup Co.*, *supra*).

“On this showing of deceptive advertising, *we do not feel inclined to permit the complainant to have the advantage of an injunction out of this court to protect its map work, and thus indirectly protect it in its polish trademark over a product to be used generally with its mop.* * * *

“This situation leaves the case without any equity in favor of the complainant.”

POINT VI.

Appellee Relies on Controlling Authorities in This Circuit. The Most Recent Decisions by the Ninth Circuit Court Held That Such Marks Are Not Confusingly Similar.

The elements of infringement and the standards to be used, were treated by this Court in the recent case of *Plough, Inc. v. Kreis Laboratories*, 314 F. 2d 635, decided by the United States Court of Appeals for the Ninth Circuit on February 20, 1963 (Rehearing Denied March 26, 1963).

In this most recent authority on the subject, this Court held the defendant's trade-marks, “COCA TAN” and “COCA TINE”, *not* confusingly similar to the plaintiff's trade-mark, “COPPERTONE”, a word which had acquired an established secondary meaning in prior litigation, both parties' marks being affixed to containers of suntan lotions, and also that defendants are not now infringing or damaging any rights plaintiff has in the names “Copa Tan, Copa Tine and Copa Cream” by reason of defendant's trademarks “COCA TAN and COCA TINT”.

The Court pointed out, at page 4, that: “We have heretofore agreed with the *Restatement of Torts, Sec. 729*, that the test in determining possibility of confusion is *appearance, pronunciation and verbal translation*”, and, after discussing the differences in phonetic sound, made the distinction, at page 6: “We keep in mind we are concerned here with a *secondary meaning* existing only as to one of the words mentioned in the injunction—the word Coppertone. *No secondary meaning was alleged, claimed or proved* as to Copatine or Copatan”.

The Court pointed out, further, at page 7:

“But one of the better ways to prove likelihood of confusion in the future is to prove it existed in the past. We cannot say there does exist a likelihood of any confusion, on the sparse record before this court. There is not one word of evidence as to the impact or effect of the supposed similarity of the products upon the market. (Citing authorities).”

The Court observed, at page 7:

*“By its filing of this proceeding, appellant attempts, not to prevent competition with any product it produces under the name of Copatan, Copatine or Copacream (for it produces none), but to prevent the marketing in the competitive market of any product marked so that it might (Court’s italic) remind one of Coppertone. * * * We cannot read, on the evidence before us, any intent to palm off ‘Coca Tan’ or ‘Coca Tint’ as ‘Coppertone’ ”.*

The Court pointed out, at page 8:

“There is an utter lack of proof:

“(a) of confusion of one person buying ‘Coca Tan’ thinking it was ‘Coppertone’ or ‘QT’ or ‘Royal Blend’, or even that it was ‘Copatan’;

“(b) That the *packages* looked similar or alike;

“(c) That the names of the products *sounded* similar or alike, as was the case in several of the cases cited in the dissenting opinion;

“(d) that there was any *exact copying*;

“(e) That there was any *effect* upon prospective customers.

*“We are convinced a two-word trademark has a different visual impact on the public than would a one-word trade-mark. * * **

“There existed in the record *no evidence of injury or damage*, or probable injury or damage.
* * *

“The burden of proving the violation rested on appellant.”

The Court held further, at page 9:

“The mere use of a name which appellees had a right to use cannot in and of itself constitute unfair competition. (Shredded Wheat—Kellogg Company v. National Biscuit Company (1938), 305 U.S. 111, 59 S. Ct. 109; “Wheaties vs Oaties”—Quaker Oats Co. v. General Mills, Inc., 7 Cir. 1943, 134 F. 2d 429.”

In the case at bar, similarly, the defendant’s mark is a two-word trademark, to wit, “TapePrinter”, having a visual impact different from plaintiff’s one-word

trademark TAPEWRITER, in addition to having a different “verbal translation” of the suffix “printer” than the plaintiff’s suffix, “writer”, and the two being different also in appearance and pronunciation, as pointed out by the Court in the cited case. Here, too, similarly, there is an “utter lack of proof” of “confusion of one person buying” a tape-printer thinking it was plaintiff’s DYMO TAPEWRITER; or that the “packages looked similar or alike”, or that the names “sound” alike, or that there was any “exact copying” or that there was any “effect upon prospective customers”; and, here, too, “no secondary meaning was alleged, claimed or proved” as to TAPEWRITER. And, similarly, in the instant case, by its filing of this proceeding plaintiff attempts not to prevent unfair competition but “to prevent the marketing in the competitive market of *any* product” that “*might*” be competitive. The conclusion is, similarly applicable here, too, that “we cannot read, on the evidence before us”, “any intent to palm off” TapePrinter as DYMO Tapewriter.

In a dissenting Opinion written in the case, the distinction was made of cases involving secondary meaning, at page 20, as follows:

“If this were a contested case in which the plaintiff was trying to procure an injunction which was resisted by the defendant, the question of whether plaintiff could claim an exclusive right to a certain name might involve a consideration of whether that name was one which must acquire a secondary meaning. But such is not the situation here.”

Nor is such the situation in the case at bar, wherein the plaintiff does not even claim that its trademark TAPEWRITER could have acquired any secondary meaning, on the Record herein.

It is noteworthy that the Ninth Circuit Court's decision in the aforesaid most recent case of *Plough, Inc. v. Kreis Laboratories, supra*, upon which defendant relies as a controlling authority herein, cited in its Opinion the "Shredded Wheat" case decided by the *Supreme Court of the United States, Kellogg Company v. National Biscuit Company* (1938), 305 U. S. 111, 59 S. Ct. 109.

In that case, the Supreme Court reversed a decree of injunction in a suit to enjoin unfair competition in use of the name "Shredded Wheat". Mr. Justice Brandeis there pointed out, at page 116:

"The plaintiff has no *exclusive right* in the use of the term 'Shredded Wheat' as a trade name. For that is a *generic term of the article, which describes it with a fair degree of accuracy.*
* * * Since the term is *generic*, the original maker of the *product acquired no exclusive right to use it.*"

It, therefore, follows, as a necessary corollary, in the case at bar, that, since the mark TAPEWRITER "is a generic term of the article which describes it with a fair degree of accuracy", the "plaintiff has no exclusive right in the use of the term" as a "trade name", and "acquired no exclusive right to use it".

The Court there also pointed out that “the name Kellogg was so prominent on all of the defendant’s cartons as to minimize the possibility of confusion”.

Similarly, in the case at bar, the plaintiff’s name DYMO is “so prominent on all of the cartons as to minimize the possibility of confusion”.

In another recent case of the Ninth Circuit, *Miles Laboratories, Inc. v. Frolich*, 132 USPQ 122 (Dec. 1961), this Court held that Milk-O-Seltzer does not infringe Alka-Seltzer nor does it unfairly compete therewith, and affirmed the judgment of the District Court “on the basis of the well-reasoned opinion” of the District Court Judge in 195 F. Supp. 256, 130 USPQ. In the lower court decision it was pointed out that the word “Seltzer” is not registrable as applied to anti-acide effervescent preparation since it is a descriptive word. It was pointed out, at page 21:

“It has been correctly pointed out that little can be gained from the citation of specific cases since each must be decided on its particular facts. (Citing authorities). However, it is important to note the trend of decisions within the circuit by which this court is bound. (Citing authorities).”

The Court pointed out further, at page 22:

“The only recent case arising within this circuit which the court has found (and none was cited) where the products were very similar and the question turned on the similarity of the names is that of *Vita-Var Corporation v. Alumaton Corporation*, SD Cal. 1949, 83 F. Supp. 214, 81 USPQ

330. In that case, Judge Yankwich, later Chief Judge of this District, held that ‘Alumatone’ was not confusingly similar to ‘Alumikote’ where the names were both applied to aluminum paint products. In that case, as here, *part of the names was identical*; * * * If anything, the case before this court now is a stronger one for denying relief since part of the alleged infringing mark is a familiar English word which is unlikely to be confused.

“Until our circuit more clearly defines these cases, it seems that the *Vita-Var* case is more indicative of the position of this circuit than the decisions of other circuits which may go further in granting trademark protection. * * * However, the court has found no case in this circuit holding marks as dissimilar as the ones in this case to be infringing. * * *

“The court is particularly impressed with the result in *Miles Laboratories v. Pepsodent Co.*, CCPA 1939, 104 F. 2d 205, 41 USPQ 738. Although *decisions of the Court of Customs and Patent Appeals* have no binding effect on this court, they *carry particular weight since they are decided by a three-judge court which specializes in this type of case*. In *Pepsodent*, the court held ‘Pepso-Seltzer’ registrable as not confusingly to ‘Alka-Seltzer’ when affixed to similar products. As in the *Alumatone* case, *supra*, the alleged in-

fringing mark was considerably closer than the mark in the case under consideration, since the middle vowel was connected to the first syllable rather than separated by a hyphen as in this case. Moreover, the first syllable there does not have the descriptive quality which 'milk' has in the present case. * * *"

The Court concluded, at page 23:

"The only genuine similarity between the marks here is the use of the word 'seltzer', as the last syllable of both. As pointed out in *The Upjohn Company v. Schwartz*, 2 Cir. 1957, 246 F. 2d 254, 262, 114 USPQ 53, 59, such similarity is not uncommon in drug compounds. The word 'seltzer' is not registrable since it is a descriptive word."

So it is in the case at bar. "The only genuine similarity between the marks here is the use of the word" "tape" as the first syllable of both. To paraphrase further, "such similarity is not uncommon" in tape products. The word "tape" is not registrable since it is a descriptive word. The words "writer" and "printer", are equally descriptive, both common words of the English language denoting the nature of the product.

It, therefore, follows, as a necessary corollary, that Appellant cannot pre-empt the word TAPEWRITER, and that, in any event, the mark TapePrinter is not confusingly similar.

POINT VII.

The Term “Write” Has Been Held Descriptive and Incapable of Exclusive Appropriation.

The word “write” and its phonetic equivalent, “rite”, have been held by the Court to be descriptive.

Among the 570 marks shown by the Record herein to have been adopted using the word “tape” or “write” or “rite” as a portion thereof, a number were almost identical to the mark of the plaintiff, TAPEWRITER, such as TAPE-RITER, and TAPERITE.

In the case of *Rite-Rite Mfg. Co. v. Rite-Craft Co.*, 85 USPQ (1960) (CCPA) (37 CCP (Patents) 963), the word “RITE” was held to be a misspelling of “WRITE” and descriptive. The mark “*Rite-Craft*” was held not confusingly similar to “*Rite-Rite*”. It was stated, at page 269:

“The prefix *RITE*, appearing in the marks of both parties, *would ordinarily have the same meaning as the word ‘WRITE’, and because of such meaning the term ‘Rite’ is descriptive, and therefore not subject to exclusive appropriation by any dealer in goods similar to those of the parties.* * * *

“From what has hereinbefore been stated, we are of opinion that *each of the marks may be used by the respective parties without likelihood of confusion and mistake in the mind of the public or deception of purchasers.*”

The same Court held, in *Clark Equipment Co. v. Baker-Lull Corp.*, 129 USPQ 220 (1961) (CCPA) (48 CCPA 865), that the marks YARDLOADER and YARDLIFT, having the same prefix, and having suffixes likewise conveying their common meaning, are so suggestive as to have little trademark significance, and pointed out, at page 221:

“That word is used to express its common, denotative meaning, viz, that the machines are primarily useful in a yard. * * * The word loader is descriptive of the use of the machine, and the word ‘lift’ is denominative of the machine itself. Purchasers are more likely to associate either of the marks with the equipment irrespective of the manufacturer, than they are to associate the words with opposer, applicant or anyone else. * * * The marks YARDLOADER and YARDLIFT *differ in meaning, appearance and sound.* * * * No word more aptly describes the primary use of these machines than ‘loader’.”

Similarly, in the case at bar, “no word more aptly describes the primary use of these machines” than TAPEWRITER and TapePrinter, as descriptive of the function of the machines involved, to-wit, to write or to print on tape.

POINT VIII.

Third Party Registrations Are Elements to Be Considered in Passing on Any Question of Likelihood of Confusion.

Notwithstanding defendant-appellee herein contests the validity of plaintiff-appellant's trademark by reason of prior third-party registrations, it has been held, in any event, that third party registrations have weight in showing that the prefix of a mark is either descriptive or suggestive and that such registrations have been held indicative that the mark is a "weak" mark without likelihood of confusion.

The Supreme Court of the United States took note of other registrations, in the case of *American Foundries v. Robertson*, 269 U. S. 372, and pointed out, at pages 380-383:

"The word 'SIMPLEX' is only a portion of the corporate name; * * * it comprises the whole or a part of about *sixty* registrations by nearly as many different parties from many kinds of merchandise; and it forms part of the names of other corporations in the country. * * * The word involved in this case is one of a large class of words which have for a great many years been much used because of their peculiarly suggestive meaning."

In a case involving tapes, *Johnson & Johnson v. Sun Chemical Corp.*, 131 USPQ 479 (1961) (PO TT&AB), third party registrations were held competent to show that the term had "a suggestive connotation as applied to goods of the character sold by the parties and to goods in general as a result of the

adoption by third persons of marks comprising this term". In that case it was held that PERMAFRESH and/or PERMAFRESH 500 did not so resemble PERMACEL and/or PERMACEL 500 for adhesive heat-sealing tapes, and like goods as to be likely to cause confusion in trade. Ten copies of registrations which issued to others, were introduced, for marks bearing the prefix PERMA, to show that PERMA was a suggestive term.

In another case involving this same tape product, *Johnson & Johnson v. Vcon Chemical Corp.*, 127 USPQ 462 (Nov. 1960) (PA TT&AB) PERMA LINE was held not confusingly similar to PERMACEL. Numerous third party registrations were introduced into evidence to show that the term PERMA had been frequently adopted as a prefix of marks in allied fields.

In another such case, *Johnson & Johnson v. Permaspray Mfg. Co.*, 125 USPQ 22 (1960), it was held that PERMASPRAY and PERMACEL, though competitive goods, were not confusingly similar, and that the third-party registrations "clearly indicate that PERMA has the suggestive significance of PERMANENT as applied". To the same effect was *Johnson & Johnson v. Permachem Corporation*, 125 USPQ 501 (May 1960), wherein PERMACHEM and PERMACEL were held not confusingly similar; also *Johnson & Johnson v. Larves Rabjohns Ltd.*, 126 USPQ 379 (1960) wherein PERMATRACE and PERMACEL were held not confusingly similar.

And in *Industrial Tape Corp. v. Reardon Co.*, 106 USPQ (1955), SUPERCEL was held not confusingly similar to PERMACEL. There were pointed out 31

registrations of marks having “cel” as the suffix for diverse items.

It has been held immaterial that any third-party registration may not be proven to be in use, in view of their purpose to show “that it has been a common practice for others to adopt the word as a part of trademarks for products in the field”. It was so held in *Motorola, Inc. v. Griffiths Electronics, Inc.*, 132 USPQ 565, which also held that, considering the suggestive nature of the word GOLDEN, descriptive GRID in THE GOLDEN GRID is sufficient to distinguish that mark from GOLDEN VOICE, GOLDEN VIEW, GOLDEN VEAM, GOLDEN M, GOLDEN SATELLITE, and GOLDEN HEART.

In *Goodall-Sanford, Inc. v. Tropical Garment Mfg. Co.*, 125 USPQ 189 (1960) (CCPA), it was pointed out, at page 190, that ROYAL PALM with palm tree was not likely to be confused with ROYAL BEACH with two palm branches, both used on wearing apparel; that “the word PALM is lacking in distinctiveness as a part of trademarks in the textile field and as such has only weak trademark significance” and that “This is shown in the record here by *ten registrations of third parties* in which the word Palm appears as a part of these marks for clothing and related goods.

In *E. L. Bruce Co. v. American Termicide Co. Inc.*, 128 USPQ 341 (1961) (CCPA) (48 CCPA 762), confusion was held not likely between TERMICIDE and TERMINIX. It was pointed out, at pages 341-342:

“The record recites registration and use by third parties of numerous marks comprising TERM and

TERMI for insecticides and termite control services. The examiner held that TERMICIDE and TERMINIX are both highly suggestive that the goods and services of both parties are designed to eliminate, kill or control termites. * * * We doubt that the purchasing public relies on TERMI to indicate the *source* of the products or services because of the inherent weakness of that prefix, *and because of the many termite exterminators who have used it in their marks as indicated by the third party registrations* * * * .”

In *U. S. Rubber Co. v. B. F. Goodrich Co.*, 135 USPQ 465 (Dec. 1962), in holding not confusingly similar the mark CIRCLE GRIP for footwear and the mark GRIPS for shoes, it was stated, at page 465:

“The fact that a number of these registrations have expired or that the registered marks have been discontinued does not, however, negate their evidentiary value in establishing the adoption by others in the footwear industry of marks comprising these various designations. (Citing authority). * * * In view thereof, opposer’s mark cannot be afforded but a limited scope of protection. * * * ”

In *Royal Petroleum Corp. v. River States Oil Co.*, 136 USPQ, in holding that likelihood of confusion does not exist as between ROYAL, ROYALUBE, ROYAL WITH BACK RS, or ROYAL 76, it was stated, at page 80:

“River States attached a number of copies of registrations disclosing marks consisting of or comprising the word ROYAL for goods akin to

those of the parties here involved. There are nineteen such registrations, the first of which issued in 1881 and the last of which issued in 1958 for the mark CONOCO ROYAL. * * * *These registrations are indicative* that in the past, and for many years, the Patent Office considered ROYAL to be a ‘weak’ mark and that composite marks including said term were registerable for like goods on the basis of no likelihood of confusion * * * *It has been consistently held* that trademarks will not ordinarily be held confusingly similar because each of them includes a word of that type. (citing authorities).”

In *Home Decorators, Inc. v. Ecco Products Co.*, 130 USPQ 153 (1961) (CCPA) (48 CCPA 1038), the word PRESTIGE was held to be a common English word suggesting a connotation of quality, and, it was pointed out, at pages 154-155: “It has been registered many times for many different kinds of merchandise”, and the decision concluded:

“We doubt that the registration of this word for bathroom, kitchen and closet accessories will dilute the word for trademark purposes or ‘cause great damage to the image’ to any appreciable degree greater *than has already been done by these other registrations.*”

In *Hiram Walker & Sons Inc. v. Milstone*, 130 USPQ 274 (1961), the marks CANADIAN CROWN and CANADIAN CLUB, both for whiskey, were held not confusingly similar. Copies of seventy-five third-party registrations were introduced for the purpose of establishing that the words were not in and of themselves distinctive as applied to whiskey.

In *Teleflex Inc. v. Telcrad Mfg. Corp.*, 127 USPQ 357 (1960), (D. Ct. SD NY), it was held worth noting, in determining strength of TELEFLEX mark, that registration had been granted to TELEFAX, TELEFACTS, TELE-FIX, TITEFLEX and TEL-FLEX on various products.

In *Sakrete Inc. v. Slag Processors, Inc.*, 127 USPQ 134 (1960), purchaser confusion was held not likely between SLAGCRETE and SAKRETE. It was pointed out, at page 134, that the Court of Customs and Patent Appeals “clearly indicated that third party registrations are admissible in evidence to show that a prefix or suffix of a mark is either descriptive or suggestive”.

In *William L. Bonnell Company Inc. v. Marglo Inc.*, 131 USPQ (1961), numerous third-party registrations were introduced to show that the marks which include the word “trim” have been frequently adopted for trim or molding material. The mark, TRIM-BRITE for plastic tape with adhesive backing, was held not likely of confusion with TRIMEDGE for plastic mouldings, TRIM-A-LUSTER for metallic trim mouldings, and TRIMENDS and TRIMALITE for plastic mouldings and TRIMEDGE for a plastic tape for molding.

In *Fleetwood Co. v. Mende*, 132 USPQ 458 (1962) (CCPA), wherein it was held confusion was not likely to arise from use of “Tint 'N Set” and “Tintz” on hair tinting preparation, the Court pointed out the weakness of the mark as an indicator of source or origin of the goods, as confirmed by the eleven third-party registrations involving the word “tint” as part of

the trademark for similar goods, and stated, at page 459:

*“The significance of third party registrations was set forth by us in Shoe Corp. of America v. The Juvenile Shoe Corp of America, 46 CCPA 868, 266 F. 2d 793, 121 USPQ 510, 512-513, where we stated: ‘If it has been frequently so used, the inference is warranted that it would be likely to be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof’. * * **

“It is unnecessary to cite the numerous other cases of this court wherein the scope to be given to weak trademarks was discussed. It seems both logical and obvious to us where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude or protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.”

The Oregon Supreme Court pointed out, in the case of *88¢ Stores, Inc. v. Martinez*, 129 USPQ 491 (May 1961), at page 494:

“A corporation, in selecting for a trade name a generic term which is descriptive of the business in which it proposes to engage, assumes some risk of injury resulting from confusion of trade names, since no one can exclusively make such an appropri-

ation. * * * There are, no doubt, *several hundred firms* * * *. *Why should one company be permitted thus to monopolize a trade name of such character?* If an exclusive appropriation can thus be made, then, with like reason, there might be a *monopoly* in the use of such names as ‘Adjusters’, ‘Printers’, and ‘Lawyers’.”

The Court concluded, at page 497:

“But the courts have generally rejected such claims to exclusive use. * * *

“The conflict may be roughly described as one between the principles of monopoly and competition. * * *

“The clear trend of the cases is in the direction of recognizing the right to compete.”

As Judge Learned Hand identified the problem, in *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 Fed. 960, 964 (2d Cir.):

“Under the guise of protecting against unfair competition, we must be jealous not to create perpetual monopolies”.

The case at bar is *a fortiori*. The Record herein shows 574 third-party trademarks and tradenames, insofar as presently known, which include either the term “tape” or the word “write” or its phonetic equivalent “rite”, for goods stated to be in various phases of the tape field, and in other fields for a variety of products, including registrations in the United States Pat-

ent Office, State Registrations and Common Law listed marks.

It has been juducially declared that the greater the number of similar third party registrations or third party trade names or trade marks, already in use, the less likelihood that their products will be associated or attributed to one source. The number of third party registrations shown herein exceed the number of those in any of the cases cited. Exhibits "A" through "D" [Tr. pp. 90-140] list the trademarks and tradenames, including a number of affidavits from third-party registrants and users establishing their adoption and use of the mark prior to the Appellant's registration of the trademark in question herein.

Why words, merely descriptive of the goods sold, receive no protection, was cogently stated by Judge Learned Hand in *Oakland Chemical Co. v. Bookman*, 22 F. 2d 930, 931:

"A 'descriptive' mark is bad for two reasons: First, because it does not in fact advise the public that the goods come from a 'single source' (Coca-Cola v. Koke Co., 254 U.S. 143, 146, 41 S. Ct. 113, 65 L. Ed. 189); second, because, if it did, since the word describes the goods, the protection of the mark would trench upon common speech which should do the same." (Citations omitted).

The Supreme Court of the United States, in *Canal Co. v. Clark*, 13 Wall. 311, 323, stated:

“He has no right to appropriate a sign or symbol, which, from the fact it is used to signify, others might employ with equal truth, and therefore have an equal right to employ for the same purpose.”

As was expressed in *Dobeckman Co. v. Boston Packaging Machinery Co.*, 107 USPQ 350 (1955), wherein “ZIP-TAPE” was held not infringed by “ZIP-CORDER”, the Court, in dismissing the Complaint in the action for trademark infringement and for injunction, declared, at page 351:

“If a party chooses an unstable mark, he must accept the consequences.”

POINT IX.

A Survey of Recent Cases Shows the Trend of Decisions Holding No Likelihood of Confusing Similarity. The Case at Bar Is A Fortiori.

MARKS HELD NOT CONFUSING

Mark	Product	Citation (Year 1963)
COZY CUFFS	slipper socks	<i>Shoe Corp. of America v. Robert Hosiery Mills, Inc.</i> , 137 USPQ 912
COZY TOES	house slippers	
THERAMIN	therapeutic vitamins	<i>Chase Chemical Co. v. Arcum Pharmaceutical Corp.</i> , 137 USPQ 910
THERAPAN	same	
SENTOL	detergent for cleaning equipment	<i>The Russell Chemical Co. v. Wyandote Chemicals Corp.</i> , 137 USPQ 908
SEN-TROL	dish washing solution	
LIDOCATION	dental and medical anesthetic	<i>Astra Pharmaceutical Products v. Pharmaton S.A.</i> , 137 USPQ 899
LIDOCAINE	same	
FLEXAC	polyvinyl acetate emulsions	<i>Standard Packaging Corp. v. Air Reduction Co.</i> , 137 USPQ 895
FLEX-VAC	same	
DUREL	plastic surface laminated panel	<i>Caradco Inc. v. West Virginia Pulp & Paper Co.</i> , 137 USPQ 910
DUREEN	plastic surfaced panels	
FRESK	preparation for making beverages	<i>Sunway Fruit Products Inc. v. Productos Caseros S.A.</i> , 138 USPQ 162
FRESHIE	concentrate for making drinks	
GET UP	soft drinks	<i>Seven-Up Co. v. Get-Up Corp.</i> , 137 USPQ 896
7 UP	same	
JAG-KNIT	men's hosiery	<i>The Jaeger Co. Ltd. v. Kayser-Roth Corp.</i> , 137 USPQ 908
JAEGER	same	
CUSH UN SOFT	ladies shoes	<i>Godman Shoe Co. v. Dunn & McCarthy Inc.</i> , 137 USPQ 896
CUSHION-STEP	arch shoe for women	
TANTAPAK	capacitor assemblies	<i>Texas Instruments Inc. v. Sprague Electric Co.</i> , 137 USPQ 454
TAN-Ti-Cap	capacitors	
TEA BREAK	tea	<i>In re Martin Gillet & Co. Inc.</i> , 137 USPQ 618
TEA TIME	same	
POLY-VUE	slidefilms projectors	<i>Polaroid Corp. v. Richard Manufacturing Co.</i> , 137 USPQ 488
POLAROID	photographic apparatus	
LULL-A-BABLE	nursing bottles and nipples	<i>Dunhill International Inc. v. Lull-A-Babe Inc.</i> , 137 USPQ 232
LULLABY	nursing nipples and bottle holders	
CIRCUITRIM	variable resistors	<i>Bourns Inc. v. International Resistance Co.</i> , 138 USPQ 95
CIRCUITRIM	same	
BASINEX	insecticides	<i>Hydroponic Co. v. Badnische A.G.</i> , 138 USPQ 94
(HYPINEX, ONEX)	plant food, rat killer bait	
(RAPONEX)	rat and mouse killer bait	
(JAPONEX)	insecticide	

Mark	Product	Citation
AEROMAGIC (AERO (AEROWAX (AEROMIST (AERO SHAVE (AERO SNOW	aerosol starch and tar remover mops and cleaning fluids self polishing floor wax glass cleaner and sprayer aerosol shaving lather artificial snow	<i>General Aerosols Inc. v. American Home Prod. Corp.</i> , 138 USPQ 60
TRUCK-LITE TRIPPE SAFETY LIGHTS	automotive lamps electric head lights	<i>Trippe Manufacturing Co. v. Truck-Lite Co. Inc.</i> , 137 USPQ 912
FLAVOR TREAT (LEMONADE TREAT (APPLE TREAT (ORANGE TREAT (CHERRY TREAT (GRAPE TREAT (ETC TREAT	beverages same	<i>Westfield Food Products Inc. v. Sunkist Growers, Inc.</i> , 137 USPQ 911
CONDADOS CONDADO	women's shoes piece goods for dresses, etc.	<i>David Crystal Inc. v. International Shoe Co.</i> , 137 USPQ 911
LOKFIN LK-FIN	Finned Tubing same	<i>In re Calumet & Hecla Inc.</i> , 137 USPQ 910
UNI-CHECK UNI-CHECK	controls for pneumatic cylinder builders' hardware, door checks	<i>Oscar C. Rixson Co. v. Deschner Co.</i> , 137 USPQ 909
SELETRON SELETRON	electronic control system current rectifier	<i>The DoAll Co. v. Noble Co.</i> , 137 USPQ 909
ORLAINE ORLANE	watches cosmetic products	<i>Jean D'Albret Sarl v. Benrus Watch Co. Inc.</i> , 137 USPQ 909
INSUL SHIELD INSUL SHIELD	insulating pipe hangers emulsion in waterproof to insulate	<i>The Lubrizol Corp. v. Insul-Coustic Corporation</i> , 137 USPQ 908
CASCADE CASCADE	prepared baking mix whiskey	<i>George A. Dickel Co. v. General Mills Inc.</i> , 137 USPQ 990
DECISION NEWSLETTER DECISION	religious newspaper guide for seeking a career	<i>Decision Inc. v. The Billy Graham Asso. Inc.</i> , 137 USPQ 801
MYSTIC MIST MAGIK MAGIK MIST	silicone fabric spray chemical products spray insecticide dispensers	<i>Knapp-Monarch Co. v. Dumas Mitner Corp.</i> , 137 USPQ 614
L'AIMANT L'AIMANT RED	toilet waters and face powder cosmetic and toilet preparations	<i>Coty Inc. v. Iwasaki</i> , 137 USPQ 487
MASTERPIECE (DUTCHMASTERS (THE MASTER CIGAR	tobacco cigars cigars	<i>Consolidated Cigar Corp. v. Liggett & Myers Co.</i> , 137 USPQ 483
SUN VALLEY SUN VALLEY	jackets and sport underwear overshoes	<i>Cambridge Rubber Co. v. Sun Valley Manufacturing Co.</i> , 137 USPQ 384
PREMIUM POP PREMIUM	popcorn in its raw state biscuits	<i>National Biscuit Co. v. Princeton Mining Co. Inc.</i> , 137 USPQ 250

Mark	Product	Citation
SACHES OF CALIFORNIA PAUL SACHS ORIGINAL	dressess "Young Missy" misses dresses	<i>Paul Saches Originals Co. v. Sachs</i> , 137 USPQ 240
CHEMFOAM, KEMFOAM CHEMFOAM	mattresses and box springs foamed materials forming sheets	<i>In re Englander Co. Inc.</i> , 137 USPQ 233
FASION GUIDE COLOR GUIDE	ties same	<i>Wembley Inc. v. Diplomat Tie Co.</i> , 137 USPQ 107
TRAN-Q (TRAN (ALVA-TRAN (TRANQUIL	tranquilizing compound therapeutic tablets pharmaceutical preparations pharmaceutical preparations	<i>Alva Tranquil Corp. v. Charles Pfizer & Co. Inc.</i> , 137 USPQ 81
LONG-GLO LONG AID	hair dressing preparations same	<i>Keystone Laboratories Inc. v. Valmor Products Co.</i> , 136 USPQ 679
LAB-TEK (LAB aid (TECHNICON	hospital laboratory equipment same same	<i>The Technicon Co. Inc. v. Labtek Plastics Co.</i> , 136 USPQ 677
"3 Way" "4 Way"	hair spray preparations for colds relief	<i>Grove Laboratories Inc. v. Shutton Inc.</i> , 136 USPQ 676
SETHCO SELCO	filtering products same	<i>The Cellulo Co. v. Sethco Manufac- turing Corp.</i> , 136 USPQ 675
CARE-AIRATOR CARbureTER	compensators for engines same	<i>ACF Industries, Inc. v. General Motors Corp.</i> , 136 USPQ 675
EPINOR DEPINAR	ophthalmic solution vitamin B-12	<i>Armour Pharmaceutical Co. v. Barnes- Hind Laboratories Inc.</i> , 136 USPQ 675
SHOW BUSINESS SHOWBIZ	show business newspaper title for cartoon panel	<i>Leo Shull Pub. Inc. v. Newspaper Enterprise Asso.</i> , 136 USPQ 675
FLEXI-PHRAGM FLEX-FLO	valves controlling fluids same	<i>Grove Valve & Regulator Co. v. G.W. Dahl Co. Inc.</i> , 136 USPQ 673
PERMA BED PERMACEL	bedding adhesives and sealers adhesives and sealers	<i>Johnson & Johnson v. Biddle Co.</i> , 136 USPQ 666
SEASORB BIO-SORB	pharmaceutical preparation pharmaceutical powder	<i>Ethicon Inc. v. Stiefel Laboratories Inc.</i> , 136 USPQ 665
DAIRY CHARM COUNTRY CHARM	butter dairy products	<i>Cooperative Quality Marketing Inc. v. Dean Milk Co.</i> , 136 USPQ 645
LINO LEGO	bricks same	<i>Interlego A.G. v. Leslie-Henry Co. Inc.</i> , 136 USPQ 601
Hi-G hi-g	electric relays valves and control systems	<i>General Controls Co. v. Hi-G, Inc.</i> , 136 USPQ 570
SUNSHOWER SUN	cream shampoos detergents	<i>La Soap Co. v. John H. Breck, Inc.</i> , 136 USPQ 488
TRUSS-SKIN TRUSCON	sheet metal for buildings steel products	<i>Republic Steel Corp. v. MPH Manu- facturing Corp.</i> , 136 USPQ 447

Mark	Product	Citation
INSTAGNESIC INSTANTINE	analgesic antirhermatic analgesic	<i>Sterling Drug Co. v. Colgate Palmolive Co.</i> , 136 USPQ 317
BLUE FERN BLUE GRASS	perfume and cologne soap and perfumes and perfumery	<i>Elizabeth Arden Sales Corp. v. Purex Corp. Ltd.</i> , 136 USPQ 276
WALLACE WALLACE SUPER DIETARY MEALZ	prescription goods and drugs dietary food	<i>Carter Products Inc. v. Fleetwood Co. Inc.</i> , 136 USPQ 252
JOY JOY OF BATHING	perfume and toilet water bath oil preparatoin	<i>Jean Patou Inc. v. Jacqueline Cochran Inc.</i> , 136 USPQ 236
GINI NEHI	soft drinks same	<i>Royal Crown Cola Co. v. Pure Spring</i> , 136 USPQ 228
SILICOTRIG SILICONTROL	electric phase controllers electrical phase shifters	<i>Vec Trol Engineering Inc. v. Bergen Laboratories Inc.</i> , 136 USPQ 283
PHARMATINIC ARMATINIC	iron composition granules containing iron	<i>Armour & Co. v. Pharmachem Specialties Inc.</i> , 135 USPQ 365
SPORTSMASTER (SKATE MASTER (SCORE MASTER	baseball gloves, baseballs roller skates leather shoes, athletic	<i>L. N. Schwartz & Sons, Inc. v. Liberty Distributors</i> , 135 USPQ 366
NOVOPHALT (NOVOPLY (NOVOCORE (NOVOTILE (NOVODOR (NOVOWALL (NOVOTEX	anti-corrosion, insulation wood particles boards of wood particles composition wood particles doors wood panels wood and lumber products	<i>U. S. Plywood Corp. v. Glaswerk Schuller G. mbH</i> , 135 USPQ 368
HEMOZYME (HEMO (HEMO-RATION	anemia tablets malted foods cereals for animals	<i>Borden Co. v. Barrows Chem. Co. Inc.</i> , 135 USPQ 370
INTERWOVEN (IN-WOV-IN (LIN-WOV-IN	hosiery same same	<i>Interwoven Stocking Co. v. Great Hosiery Mill</i> , 134 USPQ 43
KAYLENE KRYLENE	food wrap of polyethylene synthetic rubber in bags	<i>Polymer Corp. v. Papercraft Corp.</i> , 134 USPQ 45
SAFE-STEMS Q-Tips, Inc.	cotton buds (alleges descriptive)	<i>Q-Tips, Inc. v. Johnson & Johnson</i> , 134 USPQ 139
VULKENE VULCAN	building wire same	<i>In re General Electric Co.</i> , 134 USPQ 190
ABBEY or FRAIR'S MONASTERY	bread same	<i>Cistercian Abbey of Virginia v. Friar's Products Co.</i> , 134 USPQ 193
SOCIETY DEBS STYLISH DEBS	shoes same	<i>Melville Shoe Corp. v. Lester Pincus Shoe Corp.</i> , 134 USPQ 338
PIC-A-NUT TAS-T-NUT	identical product same	<i>Tas-T-Nut Co. v. Variety Nut & Date Co.</i> , 134 USPQ 349

Mark	Product	Citation
CEROLA and C-ROLA JUICE	juice	<i>Acerola Corp. v. Warner Davis Inc.</i> , 134 USPQ 378
CEROLAX and C-ROLA	same	
DYNAFAX (DYNACOLOR (DYNACHROME (DYNASTOP (DYNOL (DYNADOL (DYNADUAL	writing-camera photo film	<i>Dynacolor Corp. v. Beckman & Whit- ley, Inc.</i> , 134 USPQ 410
THERMEX THERM-A-JUG	jugs beverage containers	<i>Knapp-Monarch Co. v. Poloron Prod- ucts, Inc.</i> , 134 USPQ 413
PACIFIC MAID PACIFIC PEARL	seafoods same	<i>Wendt v. Granger</i> , 134 USPQ 414
HOME STYLE ARCHWAY HOME STYLE gurley'S HOME STYLE		<i>Venn v. Goedert</i> , 134 USPQ 442
CLOUD MIST (MIST (SCOTCH MIST (HIGHLAND MIST	woolen piece goods garments	<i>Rogers Peet Co. v. Cosmopolitan Juniors Inc.</i> , 134 USPQ 459
ELECTRO VOX ELECTRO-VOICE	intercommunications system microphones etc.	<i>In re Electro-Fox Inc.</i> , 134 USPQ 463
IGA SHOPPERS FAIR SHOPPERS FAIR	trade name same	<i>Shoppers Fair of Arkansas, Inc. v. Sanders Co. Inc.</i> , 134 USPQ 545
NILATIL NILEVAR	pharmaceutical preparation steroid preparation	<i>G. D. Searle & Co. v. Aktiebolaget Pharmacia</i> , 134 USPQ 582
NYLAFEX NYLAFLOW	tubing and hose same	<i>The Polymer Corp. v. Dayco Corp.</i> , 134 USPQ 582
TRENDLEY WEMBLEY	men's and boys' garments same	<i>Wembley v. Salant & Salant Inc.</i> , 134 USPQ 582
POWDER UP PRETTY UP	cosmetic preparations same	<i>McHam v. Gold Seal Co.</i> , 134 USPQ 583
BEAUTIQUE LINCOLN BEAUTYware & BEAUTY CAN	waste baskets	<i>Lincoln Metal Products Corp. v.</i> , 134 USPQ 584
AREOLITE BAROLITE	acrylic finishes resin adhesives	<i>Rerolite Chemical Co. Inc. v. Amer. Marietta Co.</i> , 134 USPQ 584
PETROFLUX PARA-FLUX	plasticizers same	<i>The C. P. Hall Co. v. Golden Bear Oil Co.</i> , 134 USPQ 586
GOLDEN TOUCH GOLDEN FLEECE & GOLDEN STAR	facial tissues	<i>Golden Fleece Tissue Mills, Inc. v. Swanee Paper Corp.</i> , 134 USPQ 586

Mark	Product	Citation
ACEROLA ACEREX	dietary supplements	<i>Acerex Products, Inc. v. Warner Davis, Inc.</i> , 134 USPQ 586
HIDE VYNAHYDE	plastic film	<i>Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.</i> , 134 USPQ 587
FYTE FLIT	disinfectants and deodorants same	<i>Humble Oil & Refining Co. v. Hysan Products Co.</i> , 134 USPQ 587
LAWNSMITH LAWNBOY	power lawn mowers	<i>Outboard Marine Corp. v. Yuba Power Products, Inc.</i> , 134 USPQ 587
TEMP-GARD TEMP-GARD	paints aluminum storm windows	<i>Season-All Sales Corp. v. Benjamin Moore & Co.</i> , 134 USPQ 587
NORTHMIST MIST HIGHLAND MIST SCOTCH MIST	threads and yarns men's apparel	<i>Rogers Peet Co. v. Northern Yarn Mills</i> , 134 USPQ 587
VET-A-MIX VETS'	vitamin etc. for stock canned dog and cat food	<i>Park Foods Co. v. Vet-A-Mix Inc.</i> , 134 USPQ 587
TRANSEC TRANSACTER	office dictating machines electrical data systems	<i>General Time Corp. v. Anderson Associates, Inc.</i> , 134 USPQ 587
VIE VIM	detergent preparations same	<i>Lever Brothers Co. v. The Winzer Co. of Dallas, Inc.</i> , 134 USPQ 589
CLIPPER CRAFT KLEPPER	boats same	<i>Klepper et al v. Staley</i> , 134 USPQ 589
BAR-MASTER SODAMASTER	beverage dispensers same	<i>Carbonic Dispenser, Inc. v. BarMaster, Inc.</i> , 134 USPQ 589
REGINIE REGINA	women's coats textile fabrics	<i>Deering Milliken, Inc. v. Clyde Fashions, Ltd.</i> , 134 USPQ 590
PERMAN LINE PERMACEL	thermoplastic compound pressure-sensitive adhesive tape	<i>Johnson & Johnson v. Veon Chem.</i> , 133 USPQ 393
FASHION MODES MODESS	women's garments women's goods	<i>Personal Products Corp. v. Kayser-Roth Corp.</i> , 133 USPQ 345
FLEXAC FLEXVAC	polyvinyl emulsions flexible packaging materials	<i>Standard Packaging Corp. v. Air Reduction Co.</i> , 133 USPQ 351
POLARAID POLARAID INC.	non-competing goods	<i>Polaroid Corp. v. Polaroid, Inc.</i> , 133 USPQ 67
REDI-ARC REDI-SET		<i>Air Products Inc. v. Marquette Mfg. Co. Inc.</i> , 133 USPQ 192
WIANCKO WINCO		<i>Wincharger Corp. v. Wiancko Engineering Co.</i> , 133 USPQ 378
CUP'O'Cola COCA-COLA or COKE		<i>Coca-Cola Co. v. Clay</i> , 133 USPQ 606
SIPOREX SEAPORCEL or SEAPORCLAD		<i>Seaporcel Metals Inc. v. American Siporex Corp.</i> , 133 USPQ 632

Mark	Product	Citation
CUP		<i>J.F.G. Coffee Co. v. Hafner</i> ,
GOOD CUP or FINE CUP		133 USPQ 693
UNIPEL		<i>United Co-Operatives, Inc. v. Cali-</i>
UNICO		<i>fornia Chemical Co.</i> , 133 USPQ 695
MODERN MATERIALS		<i>Materials Handling Lab. Inc. v. Indus-</i>
HANDLING		<i>trial Pub. Co.</i> , 133 USPQ 696
MATERIAL HANDLING		
ENGINEERING		
FUN FASHIONS		<i>Mercantile Stores Co. Inc. v. Cole of</i>
SUN FUN		<i>California, Inc.</i> , 133 USPQ 698
CLANSMAN'S CHOICE		<i>Austin, Nichols & Co. Inc. v. Ewart</i>
CLAMS' PRIDE		<i>Thomson & Sons</i> , 133 USPQ 700
MISS TEEN		<i>Watkins Products Inc. v. Daggett</i> ,
SWEETEEEN		133 USPQ 701
CUDDLAIRE		<i>Stardust Inc. v. Sel-Mor Garment Co.</i> ,
CUDDL'FORM,		133 USPQ 701
CUDDLE'TARD and		
CUDDL'BRA		
ELASTICSEAL		<i>Southport Paint Co. Inc. v. Kuhle</i> ,
PLASTICSEAL		133 USPQ 702
GALECOAT		<i>Alligator Co. v. B. W. Harris Manu-</i>
GOAL COAT		<i>facturing Co.</i> , 132 USPQ 97
MILK-O-SELTZER		<i>Miles Laboratories, Inc. v. Frolich</i> ,
ALKA-SELTZER		132 USPQ 122 (CA 9)
MISS BABETTE		<i>Mattel, Inc. v. Golberger Doll Mfg.</i>
BARBIE		<i>Co.</i> , 132 USPQ 243
CELACLOUD		<i>Huntington National Mattress Co. v.</i>
CLOUD, SIVER CLOUD,		<i>Celanese Corp.</i> , 132 USPQ 395
FLEECY CLOUD, etc.		
TOPP-COLA		<i>Topp-Cola Co. v. Coca-Cola Co.</i> ,
COCA-COLA		132 USPQ
MERITO	rum	<i>In re National Distillers v. Chemical</i>
MARQUES del MERITO	wines	<i>Corp.</i> , 132 USPQ 271
TINT 'N SET	hair tinting preparation	<i>Fleetwood Co. v. Mande</i> , 132 USPQ
TINTZ	same	458
DURA GREEN	grass seed	<i>Lee Patten Seed Co. v. Southern States</i>
DURA TURP	same	<i>Cooperative Inc.</i> , 132 USPQ 20
FROSTY		<i>Frostie Co. v. Sun-Glo Packers</i> ,
FROSTIE		<i>Inc.</i> , 132 USPQ 24
TINT	hair coloring	<i>Fleetwood Co. v. Lanolin Plus, Inc.</i> ,
TINTSTIK	same	132 USPQ 301

Mark	Product	Citation
KITCHENEER KITCHENAID	kitchen appliances same	<i>Hobart Mfg. Co. v. Rival Mfg. Co.</i> , 132 USPQ 301
DACA-BREEZE DAKS		<i>S. Simpson Ltd. v. Morris B. Sachs, Inc.</i> , 132 USPQ 518
DACA-BREEZE DACRON		<i>E. I. DuPont de Nemours & Co. v. Morris B. Sachs, Inc.</i> , 132 USPQ
OXY-LYFE OXY-GEAR	oxygen inhalators	<i>Oxy-Gear, Inc. v. Mayer</i> , 132 USPQ 550
THE GOLDEN GRID GOLDEN VOICE, GOLDEN VIEW, GOLDBEAM, etc.		<i>Motorola Inc. v. Griffiths Electronics, Inc.</i> , 132 USPQ 565
NU RAY ACCURAY		<i>Industrial Nucleonics Corp. v. Curtiss-Wright Corp.</i> , 132 USPQ 649
BEAUTIFUL CROWN BEAUTIFUL HAIR	hair dressing	<i>John H. Breck, Inc. v. Hollingworth</i> , 132 USPQ 696
FORMAL TIME FORMALLY YOURS		<i>Wembley, Inc. v. Superba Cravats</i> , 132 USPQ 697
OKLAHOMA'S ORBIT ORBIT		<i>S. L. Allen & Co. Inc. v. Oklahoma Publishing Co.</i> , 132 USPQ 697
TUOTITE DUOTEX	two-ply bags same	<i>Bemis Bro. Bag Co. v. Continental Can Co. Inc.</i> , 132 USPQ 697
COVER TREAT COVERMARK	fresh-tint make-up cosmetic	<i>Lydia O'Leary, Inc. v. Noxzema Chemical Co.</i> , 132 USPQ 699
CHURCH WINDOWS STAINED GLASS		<i>Wembley, Inc. v. Superba Cravats, Inc.</i> , 132 USPQ 699
IRON ACE IRON DUKE	work shirts trousers	<i>Day's Tailor Clothing Inc. v. Plymouth Dry Goods Corp.</i> , 132 USPQ 700
OLD SMOKEHOUSE THE OLD SMOKE HOUSE		<i>Ciraulo v. George A. Hormel & Co.</i> , 132 USPQ 380

POINT X.

Appellant Is Not Entitled to Preliminary Injunction.

A. Plaintiff Has Not Shown Irreparable Injury.

In denying a motion for preliminary injunction, the Court, in *Avon Shoe Co. Inc. v. David Crystal, Inc.*, 100 USPQ 17 (D Ct SD NY) (1953), pointed out, at page 20:

“These questions may be resolved favorably for judicial protection *after trial*; they are by no means sufficiently free from doubt to justify disposition upon comparison of affidavit.

“There is finally no showing by plaintiffs that any damages which may be suffered before the case can be tried on its merits will be irreparable. No diversion of customers, no loss of trade and no surrender of a current specific opportunity * * * is alleged and supported on this application. This, in addition, is reasonable ground for denial of the relief sought.”

Matters there referred to by the Court were stated as “These matters would have significant bearing on the proffered defense of laches.”

In *Allstate Ins. Co. v. Allstate Investment Corp.*, 136 USPQ 156 (1962), the Chief Judge pointed out, on judgment for defendant in an action for trademark infringement, at page 160:

“Plaintiff has been forced to admit that, notwithstanding its claim of ‘unfair competition’ by defendant, its insurance business has continued to spiral upward nationally * * *.”

In *Nadys Inc. v. Majestic Metal Specialities, Inc.*, 104 USPQ 109 (1954) (D Ct SD NY), it was expressed: "Though plaintiff claims irreparable injury, no showing has been made beyond conclusory statements in an affidavit". That seems to apply to the case at bar, since even the affidavits are sparse even as to conclusory statements and as to all else.

In *Artype, Inc. v. Zapulla*, 104 USPQ 66 (D Ct SD NY (1954)), a complaint was dismissed in an action for trade mark infringement and unfair competition and injunction denied, the Court stating, at page 69:

"It is true that a stronger prima facie case must be presented by an applicant seeking preliminary injunction in advance of trial than for similar relief after trial." (Citing authority).

In *Lascoff v. Notkoff*, 105 USPQ 143 (1955) (NY Sup Ct NY), in refusing injunctive relief in an action for unfair competition, the Court pointed out: "Mere similarity of names, in and of itself, is not sufficient basis to afford plaintiff the injunctive relief it seeks".

In *Huber Baking Co. v. Storchmann Bros. Co.*, 97 USPQ 409 (1953) (SD NY), the Court, in holding that where plaintiff's common law rights in mark and exclusiveness of mark were in doubt, stated, at page 411:

"Even should the Court feel, from examination of the papers now before it on this motion, that plaintiff will ultimately prevail after trial of these issues, the fact that his right at this stage is clearly not beyond dispute is sufficient to deny the injunction pendente lite. (Citing authorities)."

In *Tru Val Mfrs. Inc. v. Tru-Valu Corner, Inc.*, 106 USPQ (1955) (NY Sup Ct), the Court denied a preliminary injunction in a trademark infringement and unfair competition action, stating at page 161:

“The interim relief prayed for is all that the plaintiff would be entitled to obtain, injunctively, were it to succeed upon the trial, and it has not been shown that the plaintiff will be irreparably harmed should it await such relief as may granted after trial.”

In *Triumph Hosiery Mills, Inc. v. Triumph International*, 126 USPQ 233 (D Ct. NY SD), a preliminary injunction was refused in an action for trademark infringement and unfair competition involving the corporate name. The Court pointed out, at page 236: “No evidence whatsoever has been presented which would even give rise to a suspicion that defendants are likely to engage in any practice that will adversely affect plaintiff’s reputation”.

In *Armed Forces Service Co. Inc. v. Pettee*, 107 USPQ 156 (1955), the Georgia Supreme Court, in a petition seeking to enjoin corporation from using corporate name in unfair competition, stated, the Presiding Justice writing the Opinion, at page 156:

*“The allegations of the petition simply amount to an allegation that he fears defendant corporation will injure him and his business. This court has many times held that the mere apprehension of injury is not grounds to enjoin the apprehended act * * *.”*

In *Academy Award Products, Inc. v. Bulova Watch Co.*, 85 USPQ 310 (D CT NY), the court emphasized, at page 311:

“Plaintiff has not, for the purposes of this action at least, *clearly established its right to the exclusive use of the trade mark in question* and has not demonstrated that it is entitled to the drastic relief it seeks by way of preliminary injunction. * * * It is well settled that the granting of a preliminary injunction is an exercise of far-reaching power to be indulged in only in cases *clearly demanding it*. (Citing authorities).”

The Second Circuit Court of Appeals, in *Societe Comptoir vs. Alexander's Department Stores*, 132 USPQ 475 (1962), in refusing a preliminary injunction in a trademark infringement and unfair competition action, pointed out that:

“*The courts have come to recognize the true nature of the consideration often involved in efforts to extend protection of common law trade names so as to create a shield against competition*. (Citing authority). *The interest of the consumer here in competitive prices * * * is at least as great as the interest of plaintiffs in monopolizing the name.*”

B. Laches, Acquiescence and Estoppel Bar Relief.

The plaintiff's delay gives rise to a presumption that there is not that degree of urgency that would justify the issuance of a preliminary injunction. Defenses of laches, acquiescence and estoppel, present questions of fact which must be tried; such issues cannot be determined on affidavits on a motion for preliminary injunction.

In *Best Foods v. Hemphill Packing Co.*, 295 Fed. 425 (D Ct Del), the Court, in denying a preliminary injunction, pointed out, at pages 425-426:

“In the absence of justification the delay is more than sufficient to defeat plaintiff's motion for a preliminary injunction. * * * Moreover, a preliminary injunction requiring defendant to cease using its *trade name*, its slogans, and carton *would have the effect of granting all the relief obtainable by a final decree.* * * * The general purpose of a preliminary injunction is to maintain the *status quo*, and not to require the defendant *to make such changes in its affairs that, in the event it should succeed on final hearing, the injury caused to it by the temporary injunction would be irreparable.*

A preliminary injunction in the case at bar may well result in putting the defendant out of business. Thus the plaintiff would succeed in destroying competition even if it be ultimately determined at a trial that plaintiff was not entitled to the injunction.

POINT XI.

Appellant Has Not Sustained Its Burden of Proof. The Authorities Relied on by Appellant Are Distinguishable.

The appellant relies on the case of *The Fleischmann Distilling Corp. v. Maier Brewing Company* (9th Cir.) 314 F. 2d 149, decided by this Court on February 12, 1963, on the question whether the name BLACK & WHITE on beer was likely to cause confusion of the mark on whiskey.

That case was decided one week *prior* to the case of *Plough, Inc. v. Kreis Laboratories*, No. 17719, *supra*, decided by the Ninth Circuit Court on *February 20th*, 1963, one week subsequent to that Court's decision, in the *Fleischmann* case, which reversed the District Court's decision, and held for defendant, as set forth in *Point VI, supra*, of Appellee's Brief.

In any event, the *Fleischmann* case is distinguishable from the case at bar, not only because that *Fleischmann* case involved a trademark which had a *secondary meaning* but also because a *preliminary* injunction was not involved. The decision there was rendered *after trial*.

It was even pointed out in the *Fleischmann* case, at page 18 of the decision, that "each case must stand on its own facts and prior decisions are of little assistance". The decision in the *Fleischmann* case held at pages 6-7 that the mark there involved was "assuredly a strong one", and "not a descriptive term, nor does it indicate anything that has the qualities of black and white" as applied to whiskey, and that the mark there "has no such connotation". The factual distinction of the case at bar, involving as it does de-

scriptive marks and not marks having a secondary meaning, makes the *Fleischmann* case inapplicable, in any event, irrespective of the more recent *Plough* case authority.

The Appellant relies also on the case of *National Lead Company v. Wolfe*, 223 F. 2d 1954 (9th Circuit) in support of its contention that third party registrations do not preclude plaintiff's rights to the trademark. That case does not stand for any such theory. The case dealt with the *publici juris* theory but did not pass upon the precise point as to whether a prior registration deprives a registrant of property rights in a trademark. No such point was raised in the case. In any event, that case did not involve a *preliminary* injunction. The case was tried. The third party registrations in that case were shown merely for the purpose of establishing the mark as a "weak" mark and that the term "Dutch" had become public juris. In that case intentional misleading was demonstrated. That case involved a fanciful word, not a descriptive term. The case has been distinguished in subsequent cases which held contrarily under the facts of such other cases.

No further attempt will be made to distinguish the specific cases cited by appellant, since a close examination of each discloses factual distinctions which make them inapplicable to the facts of the case at bar.

Conclusion.

It is, therefore, respectfully submitted, upon all of the foregoing that, both upon authority and reason, and upon the record herein, the Order of the District Court denying plaintiff's motion for a preliminary injunction, be affirmed, accordingly.

Respectfully submitted,

ADELE I. SPRINGER,

J. CALVIN BROWN,

Attorneys for Defendant-Appellee.

Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

ADELE I. SPRINGER,

